

REMARKS

Claims 31-34, 36-53, 55 and 57-62 are active with method claims 57-61 withdrawn.

Claim 62 is added to the elected species, for which the Office has indicated allowability.

The rejection of the claims as allegedly being obvious in view of the combination of U.S. Patent No. 6,375,941 and U.S. Patent No. 5,519,063 is respectfully traversed. The underlying allegation in the rejection is that the US'941 generally describes mascara that is wax free and includes various structuring polymers. The Office concedes that US'941 does not describe the particular types of semi-crystalline polymers provided in the present application and it is for this the US'063 patent is cited. Based on these two patents the Office has alleged that it would have been obvious to include the structuring polymers from US'063 into the mascara compositions of US'941.

Applicants respectfully disagree because Piot describes aqueous -based composition whereas Mondet's compositions were specifically developed to thicken oil-based compositions and the utility in thickening an oil composition is not what one would have thought applicable to aqueous-based compositions. Further details follow.

First, the art cited does not nor does the rejection address one of the limitations in the claims, the dry solids extract of more than 45% by weight. While Applicants understand that, during the prosecution of an application in the Office, claims are to be given their broadest reasonable interpretation consistent with the teaching in the specification (*In re Bond*, 710 F.2d 831, 833 (Fed. Cir. 1990)), it is error to disregard express limitations in the claims. The

Examiner may not set up a “strawman” claim and reject it rather than subject matter encompassed by the actual claims.

The plain language of Applicants’ claims requires “a dry solids extract of more than 45% by weight” (cf Claim 1). Applicants submit that the Examiner erred in broadly interpreting the scope and content of the subject matter claimed in a manner inconsistent with the plain language of the claims and the teaching of the Specification.

The compositions of the examples of Piot are aqueous compositions and their dry solids extract is far lower than 45% by weight. Moreover, the AVALURE UR-425 used in the examples is an aqueous dispersion of polyester-polyurethane containing 49% solids (i.e. 51% by weight water).

Mondet’s thickener is the combination of two specific copolymers and is specifically an oil-thickener (see e.g. abstract) whereas the compositions of Piot are, basically, aqueous compositions: see column 3, line 1-3, and lines 29 to 36 and examples of Piot. The compositions of the examples of Piot include 47%, 58%, 58%, 58%, 57%, and 57% water. The Examiner’s reliance on column 1, lines 17 to 22 in Piot where anhydrous mascaras or mascaras with low water content are being mentioned is a discussion of the prior art describing the various types of mascaras. This passage is not specifically related to the invention of Piot because again the mascaras of Piot are specifically aqueous mascaras (see e.g.; column 1, lines 54 to 56, and examples) which do not include any wax, contrary to the aqueous mascaras, cream mascaras of the prior art as disclosed in column 1, lines 17 to 20 of Piot.

Contrary to the position in the Action, one would not have been prompted in anyway to include the thickeners of Mondet, which have been **specifically developed to thicken oil composition** for the **aqueous** composition of Piot, because the problems to be solved with each type of composition are different and not necessarily interchangeable. Said another way, that Mondet's thickeners are used for oil compositions, one looking at Mondet and Piot's aqueous compositions would be lead away from their combination. ("It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983)", MPEP § 2145)

As described by Piot in column 1, lines 17 to 22, aqueous mascaras and anhydrous mascaras are very different from each other and the teachings concerning aqueous mascaras cannot be used when formulating anhydrous (oily) mascaras and vice versa.

If one were to use the thickeners of Mondet in the compositions of Piot, the aqueous phase of Piot would have be to changed to an oil based composition and the the solid contents of the Piot's compositions would have to be increased. This is, however, contrary to the teachings of the references. (see again MPEP 2145 cited above and "the claimed combination cannot change the principle of operation of the primary reference or render the reference inoperable for its intended purpose." See MPEP § 2143.01).

As discussed in the specification at paragraphs [0020] and [0025]-[0026] in the published application: The compositions according to the invention, surprisingly, although containing no wax, exhibit a high solids content, specifically of more than 45% by weight, which the non rinsed compositions of the prior art have never been able to obtain without

incorporating waxes. Owing to the high overall solids content of the end composition and, advantageously, a satisfactory, low consistency index, generally of the order of that of known, prior art mascaras, or even less than that of known mascaras, the surprising result is an easy application, homogeneous deposition, in tandem with a satisfactory volumizing and separating effect. In other words, where the consistency is less than 1 000 Pa, the composition according to the invention makes it possible for the first time, in light of the combination of two specific parameters, each located within a specific zone, to combine excellent application properties of the composition with excellent properties of the deposition--the makeup--obtained with this composition.

Further, the composition according to the invention comprises at least one fatty phase comprising at least one particular, specific structuring agent which may, surprisingly, be incorporated into the composition even in very large amounts, which may range, for example, up to 60% by weight of the composition without substantially increasing the consistency index or causing the composition to solidify. (see [0033] of the published application)

It is completely surprising that the use of the specific structuring agent according to the invention, instead of the waxes used in the prior art, does not cause any increase in consistency and therefore makes it possible to attain overall solids contents which are much higher than in the prior art. (see [0034] of the published application)

The Office has the initial burden of proof to establish the prima facie obviousness of the subject matter Applicants claim in view of the prior art teaching. *In re Fritch*, 972 F.2d 1260, 1265 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988). Absent evidence which supports a rejection of the subject matter Applicants claim for obviousness,

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the Examiner's conclusion that Applicants' claims are unpatentable under 35 U.S.C. §103(a) must be withdrawn.

The rejection under 35 USC 112, second paragraph pertaining to Claim 54 is no longer applicable as that claim has been cancelled.

Applicants believe that the present application is in condition for allowance. Prompt and favorable consideration is earnestly solicited.

Respectfully submitted,

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